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EXAMINER

REDDICK, MARIE L

ART UNIT PAPER NUMBER

1713

DATE MAILED: 02/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/804,509

Applicant(s)

SHIROTA ET AL.

Examiner

Judy M. Reddick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06/23/03, 07/12/04 & 11/08/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9,10,12-17 and 22-39 is/are pending in the application.
- 4a) Of the above claim(s) 23-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9,10,12-17,22 and 39 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☒ Claim(s) 9, 10, 12-17 & 22-39 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. After further consideration, the amendment + counsel's persuasive arguments filed on 07/12/04 are sufficient to overcome the Murakami reference.

Election/Restrictions

2. Applicant's election without traverse of Group I (claims 9, 10, 12-17, 22 & 39) in the reply filed on 11/08/04 is acknowledged. However, the election is considered incomplete in that an election of species was made requiring applicant to elect an ultimate species of a) the instant colorant, b) the instant gelation agent, c) the instant resin component and d) the instant solvent, to which applicant did not respond (10/05/04, paragraph no. 5). Therefore, the election of species requirement is herein being repeated.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recited "wherein solvent is included at 20-80 % by weight" per claim 22 constitutes indefinite subject matter as per it not being readily ascertainable as to the exact entity that said contents are being based on, i.e., total solid composition or else.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an

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application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this

Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 9, 12-17, 22 & 39 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35

U.S.C. 103(a) as obvious over Fukuo et al (U.S. 6,203,910 B1).

Fukuo et al exemplify a solid product (crayon) formulation prepared by dissolving twelve parts by weight of a polyvinyl butyral **resin** (trade name "Denkabutyral 2000L", product of Denki Kagakukogyo Co., Ltd.) in 16 parts by weight of ethylene glycol monobutyl ether (**solvent**) and adding seven parts by weight of a pigment (Pigment Black 7, **colorant**) to the solution, followed by thorough dispersion by a mill. Added to the dispersion were 38 parts by weight of dipropylene glycol monomethyl ether (**solvent**) and 4 parts by weight of dibutyl phthalate, heating the mixture at 130 degrees C with stirring, adding 8 parts by weight of a ketone **resin** (trade name "Highlac 111", product of Hitachi Kasei Co., Ltd.) and 9 parts by weight of an amide **resin** (tradename "Barsamide 335", product of Henkeruhakusui Co., Ltd.), maintaining the mixture at 130 degrees C until complete dissolution, adding 6 parts by weight of dibenzylidene sorbitol (**gelation agent**) for complete dissolution and pouring the obtained solution into a container wherein it was cooled and solidified (Comparative Run 1). Fukuo et al therefore anticipate the instantly claimed invention with the understanding the Comparative Run 1/Run 4 overlaps in scope with the claimed solid composition.

The disclosure of a composition of matter in a reference may be anticipatory even though the reference indicates that the composition is not preferred or even that it is unsatisfactory for the intended purpose. In re Nehrenberg 126 USPQ 383. Similarly, all disclosures of the prior art, including unpreferred or auxiliary embodiments, must be considered in determining obviousness. In re Mills, 176 USPQ 196 (CCPA 1972); In re Lamberti, 192 USPQ 278; In re Boe, 148 USPQ 507.

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A reference is available for all that it teaches, including disclosures that teach away from invention as well as disclosures that point toward invention. Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 296 (Fed. Cir. 1985).

As to the wet surface property (16), it would be expected that the Comparative Run 1/Run 4 would possess this property since the solid composition exemplified is essentially the same as the claimed solid composition.

It has been held that where applicants claims a composition in terms of function, property of characteristic where said function is not explicitly shown by the reference and where the Examiner has explained why the function, property or characteristics is considered inherent in the prior art, it is appropriate for the Examiner to make a rejection under both the applicable sections of 35 USC 102 and 35 USC 103 such that the burden is placed upon applicant to provide clear evidence that the respective compositions do, in fact, differ as provided for under the guise of In re Best, 195 USPQ 430, 433(CCPA 1977); In re Fitzgerald et al, 205 USPQ 594.

As to the dependent claims, the limitations, if not taught or suggested, would have been obvious to the skilled artisan and with a reasonable expectation of success. Any additional or particular claim parameters which may not be specifically set out in the references are considered to be inherent in the reference products or not to involve anything unobvious absent a showing to the contrary. Moreover, the interchangeability of one well-known colorant for another is a matter of ordinary choice to the skilled artisan and with a reasonable expectation of success.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. Claims 9, 12-17, 22 and 39 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Okuda et al (U.S. 4,829,108).

Okuda et al disclose and exemplify a solid coating composition defined basically as containing A) at least one of a vinyl **resin** and a cellulose resin (about 3 to 15 parts by weight/100 parts by weight of solid coating composition), B) at least one of a ketone **resin** and a xylene **resin** (about 5 to about 15 parts by weight/100 parts by weight of solid coating composition), C) an acrylic **resin** (about 10 to about 25 parts by weight/100 parts by weight of solid coating composition), D) at least one **gelling agent** (about 3 to about 12 parts by weight/100 parts by weight of solid coating composition) which includes benzylidene sorbitol, dibenzylidene sorbitol, tribenzylidene sorbitol and sorbitol derivatives, E) **at least one** organic solvent (about 30 to about 60 parts by weight/100 parts by weight of solid coating composition) which includes an ether of a glycol, ether ester of a glycol and a benzoic acid ester, F) a **pigment** (about 0.3 to about 35 parts by weight/100 parts by weight of solid coating composition) and G) other conventional additives. See, the Abstract, col. 1, lines 47-68, col. 2, lines 1-23, col. 3, lines 1-68, col. 4, lines 1-68, col. 5, lines 1-68, col. 6, lines 1-68, col. 7, lines 1-25, the Runs and Claims of Okuda et al. More specifically, Okuda et al exemplify solid coating compositions derived from 80 parts of ethylene glycol monobutyl ether & 15 parts of ethylene glycol monobutyl ether (sufficient to meet the solvent mixture per claim 9 (ii)), 20 parts of polyvinyl butyral (sufficient to meet the resin component per claim 9), 15 parts of titanium oxide (sufficient to meet the colorant per claim 9), 4 parts of dibutyl phthalate, 6 parts of benzylidene sorbitol, 7 parts of ketone resin and 15 parts of acrylic resin (sufficient to meet the resin component per claim 9). See at least Run 1. Okuda et al therefore anticipate the instantly claimed invention with the understanding that the solid composition of Okuda et al overlaps in scope with the claimed solid composition. The use of the solid coating composition as a solid writing material, wet-surface writing material and crayon is tenable since the solid composition of Okuda et al is essentially the same as the claimed solid composition. The burden to show that this, in fact, is not the case is shifted to applicants to show otherwise. Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

It has been held that where applicants claims a composition in terms of function, property of characteristic where said function is not explicitly shown by the reference and where the Examiner has explained why the function, property or characteristics is considered inherent in the prior art, it is appropriate for the Examiner to make a rejection under both

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the applicable sections of 35 USC 102 and 35 USC 103 such that the burden is placed upon applicant to provide clear evidence that the respective compositions do, in fact, differ as provided for under the guise of *In re Best*, 195 USPQ 430, 433 (CCPA 1977); *In re Fitzgerald et al*, 205 USPQ 594.

The discovery of a new property or use of a previously known composition, even if unobvious from the prior art, cannot impart patentability to claims to a known composition. *In re Spada* 15 USPQ 2d 1655 (CAFC 1990).

As to the dependent claims, if not taught or suggested, the limitations would have been obvious to the skilled artisan and with a reasonable expectation of success. Any additional or particular claim parameters which may not be specifically set out in the references are considered to be inherent in the reference products or not to involve anything unobvious absent a showing to the contrary.

Even if it turns out that the claims are not anticipated, it would have been obvious to the skilled artisan to extrapolate, from *Okuda et al*, the precisely defined solid composition, as claimed, as per such having been within the purview of the general disclosure of *Okuda et al* and with a reasonable expectation of success, absent a clear showing of unexpected results commensurate in scope with the claims.

Allowable Subject Matter

10. Claim 10 is allowable over the prior art of record as per said art neither anticipates nor renders obvious the precisely defined solvent mixture, as claimed. One having ordinary skill in the art would not have been endowed with any motivation to extrapolate, from any of the prior art disclosures, the precisely defined solvent mixture, as claimed, with any reasonable expectation of success.

11. Claim 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

12. Applicant's arguments filed 06/23/03 & 07/12/04 have been fully considered but they are not persuasive.

Relative to *Okuda et al*----The crux of Counsel's arguments appears to hinge on the failure of patentee to disclose a solid composition comprising a colorant, a gelation agent, a resin component and **at least two particular solvents**. To this end, it is urged and maintained that the composition exemplified per at least Run 1 houses a composition

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comprising a colorant, gelation agent, resin component and combination of solvents meeting the claimed composition as described per at least claim 9 (ii).

Relative to Fukuo et al-----Firstly, a rejection based on Fukuo et al was made in a previous Office action (12/11/02) and withdrawn in the following Office Action (09/30/03). However, after an extensive review of this prior art and further consideration, a rejection based on this prior art is deemed proper as is set forth supra. Counsel is herein reminded that a reference is evaluated, as a whole, for what it fairly teaches and is in no way limited to just bits and pieces and to this end, Comparative Run 1 clearly teaches the solvent combination + colorant, gelation agent and resin component overlapping in scope with the claimed composition.

The disclosure of a composition of matter in a reference may be anticipatory even though the reference indicates that the composition is not preferred or even that it is unsatisfactory for the intended purpose. In re Nehrenberg 126 USPQ 383. Similarly, all disclosures of the prior art, including unpreferred or auxiliary embodiments, must be considered in determining obviousness. In re Mills, 176 USPQ 196 (CCPA 1972); In re Lamberti, 192 USPQ 278; In re Boe, 148 USPQ 507.

A reference is available for all that it teaches, including disclosures that teach away from invention as well as disclosures that point toward invention. Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 296 (Fed. Cir. 1985).

Furthermore, unexpected results are immaterial to a rejection under 35 USC 102 (In re Malagari, 182 USPQ 549 (CCPA 1974)).

Conclusion

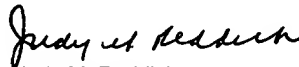
13. The additional prior art listed on the attached FORM PTO 892 is cited as of being illustrative of the general state of the art.


14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (571) 272-1110. The examiner can normally be reached on 6:00 a.m. - 2:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR 
02/04/05